

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional):

2002-014/PU02 0199US1

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Date: **December 6, 2006**

Signature:


Typed or printed name: **KATHLEEN KOPPEN**

Application Number:

10/627,896

Filed:

July 25, 2003

First Named Inventor:

Mahini

Art Unit:

2617

Examiner:

ARIEL BALAOING

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.

(Form PTO/SB/96)

☒

attorney or agent of record

Registration Number: _____

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attorney or agent acting under 37 CFR 1.34.

Registration Number if acting under 37 CFR 1.34 _____



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December 6, 2006_____
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

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*Total of _____ form(s) is/are submitted.

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. ¹ Applicant's unique citation designation number (optional). ² Applicant is to place a check mark here if English language Translation is attached. This collection of information is required by 37 CFR 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of
Hassan Mahini

Serial No.: **10/627,896**

Filed: **July 25, 2003**

For: **Event List Menu for Accessing Menu
Items in a Hierarchical Menu**

Docket No: **2002-014**

PATENT PENDING

Examiner: Ariel Balaoing

Group Art Unit: 2617

Confirmation No.:4007

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December 6, 2006

Date

Kathleen Koppen

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ARGUMENTS PRESENTED FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Applicants submit the following remarks in support of the Pre-Appeal Brief Request for Review. Currently, claims 1, 4-10, 13-19, and 22-28 are pending and stand finally rejected over Salmimaa (U.S. Pat. No. 6,668,177) in view of Ogilvie (U.S. Pat. No. 6,487,586). Claims 29-34 have been withdrawn from prosecution in light of the Examiner's final restriction requirement.

Claim 1 is directed to a method of accessing functions in a mobile communication device such as a cellular telephone. As recited by claim 1, the claimed invention dynamically updates a list of shortcuts responsive to designated events. Claim 1 labels these shortcuts on the event list as "events on an event list." When a new designated event occurs, a shortcut is added to the list and associated with a menu item in a hierarchical menu. The user may then invoke the particular menu item by selecting the shortcut from the list. Once the user responds to the

event, the shortcut is deleted from the list. Therefore, the size of the shortcut list increases and decreases dynamically. For reference, claim 1 appears below.

1. A method of accessing functions in a mobile communication device comprising:
 - dynamically updating an event list responsive to designated events by adding events to said event list when a new event occurs and automatically deleting events from said event list when a user responds to an event;
 - displaying said event list to a user on a display;
 - associating a menu item in a hierarchical menu with each event in said event list; and
 - invoking the associated menu item in said hierarchical menu responsive to selection of an event from said event list by said user.

The Examiner alleges that combining Salmimaa and Ogilvie renders claim 1 obvious. However, this assertion is incorrect and completely unsupported by the references. Whatever Salmimaa and Ogilvie disclose, alone or in combination, is irrelevant to claim 1.

The primary reference, Salmimaa, discloses generating icons for placement on a computer desktop displayed to the user. Once the icons are generated, Salmimaa maintains them on the desktop so that a user can invoke an underlying application program associated with the icon. Salmimaa recognizes that the size of the display device limits the number of icons that can be usefully displayed. Particularly, the desktop displayed to the user becomes "crowded" and confusing as the number of icons increases. Therefore, the fundamental goal of Salmimaa is to permit a large number of icons to be represented on a relatively small size display. *Salmimaa*, col. 2, ll. 9-12. To accomplish this, Salmimaa scales the sizes of the icons to appear larger or smaller to the user based on their importance to the user. *Salmimaa*, col. 2, ll. 33-51. Icons that are more important appear larger, while icons that are less important appear smaller. *Salmimaa*, col. 2, ll. 33-51.

Re-sizing icon size does not teach or suggest deleting icons from the desktop when a user responds to an event to dynamically update the list. In fact, the opposite is true. Scaling icon size as in Salmimaa allows users to maintain as many icons as possible on the desktop. That is, reducing the sizes of the icons provides more display space for icons. Therefore,

Salmimaa explicitly prevents users from having to delete icons from the desktop – even those that are rarely used. *Salmimaa*, col. 1, ll. 58-63.

The secondary reference, Ogilvie discloses removing unwanted e-mail messages (i.e., SPAM) from a computer, and is therefore even less relevant to claim 1 than Salmimaa. In Ogilvie, incoming e-mail messages include a specialized directive in their headers. Receiving devices also include “removal code” or logic that can translate these removal codes. Particularly, once the message is received, the removal code will, based on the header directives, automatically remove the incoming e-mail messages after the elapse of a pre-determined period of time, or when some other event occurs.

Ogilvie never hints at dynamically updating a shortcut list by adding and automatically deleting shortcuts from the list. In fact, the Ogilvie method directly affects the underlying e-mail message itself. As such, whatever Ogilvie teaches is utterly irrelevant to shortcut lists of any kind.

Neither Salmimaa nor Ogilvie teaches or suggests, “dynamically updating an event list responsive to designated events by adding events to said event list when a new event occurs and automatically deleting events from said event list when a user responds to an event.” Therefore, the references cannot be combined to teach or suggest claim 1.

In addition, there is no motivation to combine the references. Each reference is fundamentally concerned with solving a different problem, and both use different technologies. Salmimaa alters the sizes of the icons on the desktop, while Ogilvie removes unwanted SPAM for the user. No one skilled in the art would be motivated to modify a reference that teaches scaling icon size with one that teaches removing e-mail to produce an invention that dynamically updates a shortcut list.

Even the attempt to combine the references is non-sensical. Salmimaa makes a concerted effort to maintain icons on the desktop even if those icons are rarely used.

Salmimaa, col. 1, ll. 58-63. Ogilvie, in contrast, makes a concerted effort to remove unwanted e-mail messages. Neither has anything to do with the other, nor is there any motivation to combine the references. Therefore, the §103 rejections to each of the claims fails as a matter of law and must be withdrawn.

The Panel should note that the § 103 rejection is based on fundamentally improper claim construction. The Examiner contends that the events of claim 1 do not equate to “shortcuts.” The Examiner maintains this contention despite the language of claim 1 and despite Applicant’s explicit statements to the contrary.

Claim 1 recites that each event on the list is associated with a hierarchical menu item, and that by selecting an event, the user invokes the associated menu item. This functionality – i.e., invoking an associated menu item upon selection of an event – is not the functionality of the underlying event. Rather, it is the functionality associated with a shortcut.

The Examiner cites paragraph 0008 of the specification in an attempt to show otherwise; however, the cited paragraph only broadly describes what underlying events may be – it does not describe the function of the shortcuts on the event list. Those particular functions are described in more detail, for example, in Examples 1-3 on pages 10-12 of the specification. Particularly, these examples describe some of the underlying events as being missed voice calls, missed MMS messages, unread SMS messages, alarm set by the user, interfaces (e.g., BLUETOOTH) set by the user, and unread email messages. They also explicitly state that a user selecting an event from the list invokes a menu item associated with that event. By way of example, a user selecting the “Missed Calls” event will be taken directly to the missed calls menu. Similar functionality also occurs in the other examples. *Spec.*, pp. 10-12.

The specification fully supports Applicant’s stated position that the events on the event list are shortcuts to the events. It also unambiguously contradicts the Examiner’s assertion. The Examiner must construe claim 1 as supported by the specification, and as explicitly stated

by the Applicant during prosecution. The Examiner is not permitted to distort the claims by assigning a broad, unreasonable meaning to the terms of the claim – especially where that assigned meaning is unquestionably unsupported.

In sum, the references fail to teach or suggest claim 1, alone or in combination. Therefore, the §103 rejection of claim 1 falls and must be withdrawn.

Additionally, the Examiner also rejected claims 10, 19, and 28 as being obvious over Redmann in view of Ogilvie for substantially the same reasons as those stated above. Claims 10, 19, and 28, however, are directed to a mobile communication device, a circuit for controlling a user interface, and a computer program, respectively. Each of these independent claims contains language similar to that of claim 1. Therefore, for reasons similar to those stated above, Redmann in view of Ogilvie also fails to teach or suggest, alone or in combination, any of claims 10, 19, and 28. Moreover, because the independent claims are patentable, so, too, are all dependent claims.

In light of the above remarks, Applicant respectfully requests that the Panel overturn the Examiner's rejections.

Respectfully submitted,

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